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Erik B. Cherdak  
Duane Morris LLP  
1667 K Street, N.W., Suite 700  
Washington, D.C. 20006

In re Application of	:	DECISION ON
SIM et al	:	
PCT No.: PCT/GB03/04828	:	
Application No.: 10/533,631	:	
Int. Filing Date: 06 November 2003	:	PETITION UNDER
Priority Date: 06 November 2002	:	
Attorney's Docket No.: 108347-0041	:	
For: CONFIGURABLE FUNCTIN ...	:	
ANALOGUE CONVERTERS	:	37 CFR 1.47(b)

This decision is in response to applicants' "RESPONSE TO NOTICE OF MISSING REQUIREMENTS AND PETITION UNDER 37 CFR 1.47(b)" submitted on 17 May 2006 that seeks the acceptance of the application without the signature of the inventors Calvin SIM and Christofer TOUMAZOU. The petition fee under 37 CFR 1.17(g) of \$200.00 has been charged to petitioner's Deposit Account No. 04-1679.

**BACKGROUND**

On 06 November 2003, applicant filed international application PCT/GB03/04828, which claimed priority of an earlier application filed 06 November 2002. A copy of the international application was transmitted to the United States from the International Bureau on 21 May 2004.

On 02 May 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 17 October 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification also indicated that the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(h) for small entity must be filed. The notification set two months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 17 May 2006, the following:

- 1) A petition under 37 CFR 1.47(b);
- 2) A Declaration And Power of Attorney unsigned;
- 3) Response to Notice of Missing Requirements and petition
- 4) the required petition fee.

### **DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

#### **REFUSAL TO JOIN:**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an

express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

**UNAVAILABILITY:**

"Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter instructions, telegrams, etc. that support a finding that the nonsigning inventor could not be found or reached should be made a part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter instructions, telegrams, etc. that support a finding that the nonsigning inventor could not be found or reached should be made a part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Applicant has satisfied items (1) and (3), and but not items (2) and (4) - (6) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) because the petition fee has been provided by petitioner.

Regarding requirement (2), petitioner has not provided sufficient evidence that Calvin SIM and Christofer TOUMAZOU refused to sign the declaration. The averments of Mr. Cherdak are not sufficient to support a finding that the nonsigning inventors, Calvin Sim and Christofer Toumazou refuse to sign because it is unclear if a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventors for their signatures, and that the inventors refused to sign the required papers. The petition and e-mails refer to the declaration and there is no mention of the specification.

Moreover, no documentary evidence to support this assertion has been provided such as the postal receipts, and copies of the cover letters to show documentary evidence of a bona fide attempt to present the application papers to Calvin Sim and Christofer Toumazou.

In addition, based on the petition it is unclear if they still reside in their respective addresses. If not, then petitioner is under an obligation to try to find or reach them. Where there is an inability to find or reach a joint inventor "after diligent effort," petitioner may file a statement of facts that fully describes the exact facts which are relied on to establish that a diligent effort was made under **37 CFR 1.47**.

Moreover, it is not clear from the petition that it was Mr. Cherdak who performed the items listed in the petition, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Cherdak was not the person who performed the actions listed in the petition, petitioner will need to submit statements, with specific facts on the actions referred to by the petition by persons who have first-hand knowledge of such facts.

Regarding item (3), petitioner has stated the last known addresses of the inventors:

Calvin SIM  
46B Bramham Gardens  
London SW5 0HQ  
Great Britain

Christofer TOUMAZOU  
8 Barrett Street  
Oxford, Oxfordshire OX2 0AT  
Great Britain

Regarding item (4) a declaration has not been provided executed by an appropriate person on behalf of the non-signing inventors.

Regarding item (6) applicant has not presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding item (5) applicant has not submitted proof that applicant has sufficient proprietary interest in the application. Mr. Sharland's statement is not sufficient without corroborating evidence since there is no copy of the assignment (signed assignment by inventor Mr. McHutchinson) provided with this petition.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) petitioner must demonstrate that applicant otherwise has a sufficient proprietary interest in the matter. A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. Note MPEP 409.03(f)

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

### CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Tel: (571) 272-3276  
Fax: (571) 273-0459